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APPLICATION NO.	O. FILING DATE		FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,327	09/926,327 10/15/2001		Piero Del Soldato	108907-00021	5185
4372	7590	03/12/2004		EXAMINER	
	X KINTNER	BADIO, BA	BADIO, BARBARA P		
1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036				ART UNIT	PAPER NUMBER
				1616	
				DATE MAILED: 03/12/2004	4

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)					
	09/926,327	SOLDATO, PIERO DEL					
Office Action Summary	Examiner	Art Unit					
	Barbara P. Badio, Ph.D.	1616					
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply							
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).							
Status							
1) Responsive to communication(s) filed on	Responsive to communication(s) filed on						
2a) This action is <b>FINAL</b> . 2b) This	This action is <b>FINAL</b> . 2b) ☐ This action is non-final.						
·— ···							
closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.							
Disposition of Claims							
<ul> <li>4) ☐ Claim(s) 1-12 is/are pending in the application.</li> <li>4a) Of the above claim(s) is/are withdrawn from consideration.</li> <li>5) ☐ Claim(s) is/are allowed.</li> <li>6) ☐ Claim(s) is/are rejected.</li> <li>7) ☐ Claim(s) is/are objected to.</li> <li>8) ☐ Claim(s) 1-12 are subject to restriction and/or election requirement.</li> </ul>							
Application Papers							
9) The specification is objected to by the Examine 10) The drawing(s) filed on is/are: a) accomposed and applicant may not request that any objection to the Replacement drawing sheet(s) including the correct 11) The oath or declaration is objected to by the Example 11.	epted or b) objected to by the Eddrawing(s) be held in abeyance. See ion is required if the drawing(s) is obj	e 37 CFR 1.85(a). ected to. See 37 CFR 1.121(d).					
Priority under 35 U.S.C. § 119							
<ul> <li>12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</li> <li>a) All b) Some * c) None of:</li> <li>1. Certified copies of the priority documents have been received.</li> <li>2. Certified copies of the priority documents have been received in Application No</li> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> <li>* See the attached detailed Office action for a list of the certified copies not received.</li> </ul>							
Attachment(s)  1) Notice of References Cited (PTO-892)  2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date	4) Interview Summary Paper No(s)/Mail Da 5) Notice of Informal P 6) Other:						

Application/Control Number: 09/926,327

Art Unit: 1616

## **DETAILED ACTION**

## Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, 2, 4 and 7-12 (in part), drawn to compounds of examples 1 and 2 and compositions and use thereof.

Group II, claim(s) 1, 2, 4 and 7-12 (in part), drawn to compounds of examples 3-5 and compositions and use thereof.

Group III, claim(s) 1-12, drawn to compounds not defined by Groups I and II and compositions and use thereof.

- 2. The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The compounds of the claims contain a steroid moiety which does not define a contribution over the prior art. The substituents on the steroid moiety vary extensively and when taken as a whole result in vastly different compounds. Accordingly, unity of invention is lacking and restriction of the invention in accordance with the rules of unity of invention is proper.
- 3. Applicant is required, in reply to this action, to elect a single disclosed species (e.g. Example), from under the elected Group, for search purposes. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Application/Control Number: 09/926,327

Art Unit: 1616

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

## Telephone Inquiry

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio, Ph.D. whose telephone number is 571-272-0609. The examiner can normally be reached on M-F from 6:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Barbaro Padio Barbara P. Badio, Ph.D.

Page 3

Primary Examiner

Art Unit 1616

BB March 10, 2004